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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,547	09/24/2003	Craig Stephen Slavtcheff	J6827(C)	4643

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UNILEVER INTELLECTUAL PROPERTY GROUP
700 SYLVAN AVENUE,
BLDG C2 SOUTH
ENGLEWOOD CLIFFS, NJ 07632-3100

EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/669,547

Applicant(s)

SLAVTCHEFF ET AL.

Examiner

Gina C. Yu

Art Unit

1617

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: None.
Claim(s) rejected: 1-17.
Claim(s) withdrawn from consideration: None.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See continuation sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s) _____
13. ☐ Other: _____


**SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER**

Continuation sheet: No. 11. The request for reconsideration has been considered but does not place the application in condition for allowance because the arguments are unpersuasive.

Applicant asserts that the present invention differs in "concept and composition from that of the primary reference". Examiner respectfully points out that a prima facie case of obviousness is established if combined teachings of prior arts would have provided some motivation to a skilled artisan at the time of the present invention. In response to applicant's argument that applicants used mineral oil for different purposes than as taught in LaHann (US 4546112), examiner reiterates that, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). For example, while applicants assert that mineral oil is not taught as an active agent in LaHann, that does not negate the motivation to use mineral oil in the composition as suggested by LaHann and Michaels (US 3843780). LaHann teaches the method of pretreating the skin to be depilated with an anti-irritant composition, while Michaels teaches that mineral oil functions as an anti-irritant which is used as a shaving pretreatment. Applicant's assertion that the function of mineral oil used in the Michael is in "different kind" is unpersuasive. Based on the teaching in Michael, the routineer would have chosen to employ mineral oil to "provide comfort, soothing effect to the skin" without any irritation, which is the claimed method of the present case.

Applicant asserts that Ex parte Obiaya does not apply to the present case because prima facie case of obviousness has not been established. See 227 U.S.P.Q 58 (Bd. Pat. App. & Inter. 1985. Examiner respectfully disagrees, as the rejection is viewed proper and maintained for the reasons of record and as explained here.

Applicants also assert that shaving and depilatory treatments are significantly different because the latter is a chemical treatment. In response, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, examiner takes the position that LaHann and Michaels are analogous arts because both are concerned with reducing preventing and/or reducing skin irritation caused by hair removal process, which is the problem with which applicant is concerned. Furthermore, applicant's argument is not persuasive because it cannot be said, nor does applicant have any supporting factual evidence, that mineral oil which soothes the skin irritation caused by sharpened blade will somehow not be effective on the skin irritation caused by depilation.

In response to applicants' comment that no citation is made in Michaels where "up to 87 % of lipophilic materials" is used, examiner respects points out that in the preceding paragraph of that statement is the discussion of the disclosed formula comprising 85 % of mineral oil and 2 % of lanolin, which is a lipophilic emollient. See Office action (April 5, 2006), p. 3, 3rd par.

Applicants also assert that Michaels “teaches away” from using higher than 85 % of mineral oil because the prior art composition contains other ingredients. In response, examiner notes the Michael reference does not specifically limits the amount of the mineral oil or the anhydrous alcohol. Examiner is unable to find any teaching in Michael that would have taught away the routineer from combining the reference with LaHann. Applicants’ assumption that a skilled artisan would refrain from using higher amount of mineral oil than 85 % is rather subjective. Furthermore, the reference also teaches using emollient components, which are lipophilic materials and added to the weight amount of the lipophilic phase.

It is also noted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, the suggested teaching of the references is that mineral oil is used as the main vehicle of the composition to reduce skin irritation as applicant has done. Discovery of the optimum weight amount of the lipophilic materials used in the composition by routine experimentation would have been obvious to the skilled artisan.

Applicant also asserts that In re Aller is not applicable in this case because that case was a rejection over a single reference wherein the present rejection combines two different references. Examiner is not aware of any restriction that this case law is

limited to the specific instances where an obviousness rejection at issue is made with a single reference only.

In response to the examiner's treatment of the transitional phrase "consisting essentially of" as "comprising" in pursuant to MPEP § 2111.03, applicant refers to Example 1 and 2 in the specification. The cited disclosure there merely describes that the pretreatment with mineral oil produced effective depilation and less irritation, which is expected in view of LaHann and Michaels. There is no showing in applicant's disclosure that introducing additional materials to this skin pretreatment composition would somehow affect the depilation and the reduction of skin irritation results.

With respect to the § 103(a) rejection made over LaHann and Michaels and further in view of Orlow et al. (US 6749740 B2), applicant highlights what each reference fails to teach. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant's arguments with respect to the § 103(a) rejection made over LaHann, Michaels and Orlow and further in view of Syed et al. (US 5756077), are also unpersuasive, as the above preceding rejections are viewed proper and maintained for the reasons of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 9:00AM until 6:30 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu
Patent Examiner